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REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

Regarding the Objection to the Specification

Applicant has corrected the noted defect in the specification and appreciates the Examiner's notation of such errors. Reconsideration is respectfully requested.

Regarding the Claim Objections

Applicant has corrected the noted defects in the claims and appreciates the Examiner's notation of such errors. Reconsideration is respectfully requested.

Regarding the Rejections under 35 U.S.C. §102

All claims (1-36) have been rejected as anticipated by the Draft EIA-775A, DTV 1394 Interface Specification (hereinafter EIA) submitted by Applicant. Applicant respectfully requests reconsideration of all rejections in view of the following:

Specifically regarding Independent claims 1, 15, 23 and 26:

Using claim 1 as an illustrative example, the Office Action states that "*determining that digital bitmap image is larger in size than a threshold*", as called for by the claim, is found at least at p.13, sections 3.2.1 and 3.3 and asserts that "the application running on the A/V Source will determine the means (e.g., analog or digital) for delivery of the OSD based on the delivery capability of the information returned from the DTV".

However, what EIA actually states is that "the application running on the A/V Source may use its NTSC analog video output as a display method for GUIs. It may overlay its own OSD onto the NTSC analog signal before delivery to the display." In other words, the A/V Source may use analog video as the display method for Graphical User Interfaces (GUI) and On Screen Displays (OSD). Applicant finds no further teaching relevant to this claim feature.

Application No.: 10/067,036

While EIA certainly provides for transmission of both analog and digital data from the A/V Source to the DTV, there is no teaching or suggestion of basing the selection of analog versus digital upon comparison of the size of a digital bitmap image to a threshold size. Moreover, the Office's explanation does not lead to a conclusion that this is the basis for selection of analog versus digital. Rather, the Office's assertion is apparently that the decision as to whether to transmit analog versus digital is carried out in an application running on the A/V source based upon the capabilities of the DTV as determined by the A/V Source's ability to discover certain information relating to the DTV's capabilities using its discovery capability discussed in sections 3.3 and 9 of EIA (see second paragraph of page 2 of the Office Action). Applicant finds no solid support even for this position, but notes emphatically that this position, even if correct, does not meet the claim feature at issue. Applicant finds no teaching or suggestion that the application running on the A/V meets the claim feature.

In order to establish that the claim is unpatentable under 35 U.S.C. §102, it is fundamental that each and every claim feature must be found explicitly or inherently in a single reference (see MPEP 2131), and each and every claim feature must be fully and properly considered. In this case, EIA fails to fairly teach or suggest the feature of comparison of a size of a digital bitmap image to a threshold as a mechanism for determination whether analog or digital transmission to the DTV is to be used as claimed (to paraphrase without intent of imposing limitations). Applicant finds no such teaching or suggestion in EIA. Hence, *prima facie* unpatentability of claim 1 has not been established.

Claims 15, 23 and 26 contain similar features and hence the above arguments are equally applicable. For example, in claims 15 and 23 the "determining" function is entirely analogous to that argued in connection with Claim 1. As to claim 26, there is no teaching or suggestion that the resident or downloaded application and OSD generator of FIG. 3 carry out the function of determining if the size of the bitmap image exceeds a threshold as asserted.

In view of this failure to establish anticipation of claims 1, 15, 23 and 26, claims 2-14, 16-22, 24-25 and 27-36 are also submitted to be patentable for at least the same reasons as those discussed for claim 1. Other distinctions also exist, but need not be addressed in view of the

Application No.: 10/067,036

Office's failure to meet its obligation to establish unpatentability. Reconsideration and allowance of claims 1-14 are respectfully requested.

Specifically regarding claims 14 and 22:

It is noted that the Office Action incorrectly indicates that claims 14 and 22 are independent claims, but in fact for the record, claims 14 and 22 are dependent upon claims 1 and 15 respectively. The above remarks are applicable.

Concluding Remarks

The undersigned notes that many other distinctions exist between the cited art and the claims. However, in view of the clear distinctions pointed out above, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort. No amendment made herein was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references. The amendments merely correct grammatical errors.

Interview Request

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date. If further matters remain to be resolved, the undersigned respectfully requests the courtesy of an interview. The undersigned can be reached at the telephone number below.

Respectfully submitted,

/Jerry A. Miller 30779/

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Application No.: 10/067,036

-10-

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Application No.: 10/067,036

-11-